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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,292	02/26/2004	Peter Bosshart	004501-761	3842

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EXAMINER

PATEL, SHAMBHAVI K

ART UNIT	PAPER NUMBER
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2128

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/786,292	Applicant(s) BOSSHART ET AL.	
	Examiner Shambhavi Patel	Art Unit 2128	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/26/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-15 are pending.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Information Disclosure Statement

3. The information disclosure statement filed 26 February 2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because translations for all foreign documents have not been provided. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

- i. The Examiner asserts that the current state of the claim language is such that a reasonable interpretation of the claims would not result in any useful, concrete or tangible product. **Claim 1** is directed to a data processing device for computer-aided tendering of power supply facilities, and **claim 11** is directed to a method of tendering a power supply facility. This claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful, concrete and tangible result. Specifically, the claimed subject matter does not produce a tangible result because the claimed subject matter fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter provides for modules that, when executed on the projected facility, create tendering information about the projected facility, and running application routines by the operator on the modules of the projected facility to create tendering information about the projected facility. These produced results remain in the abstract and, thus, fail to achieve the required status of having real world value.
- ii. **Claim 1** is an apparatus claim, but is not statutory because it is directed to software, per se. It is lacking storage on a medium that would enable any underlying functionality to occur.

All other claims are rejected by virtue of their dependency.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1-15 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Garcia (US Pub. 2002/0042696).

Regarding claims 1 and 11:

Garcia discloses a data processing device for computer-aided tendering of power supply facilities, in particular substations (abstract), comprising computing means and a module library for storing program modules represented pre-engineering parts of the facility, which modules can be retrieved from the library for being used in projecting the facility [0012], wherein

- a. the modules are categorized using a multiple-index categorization system (figure 6; [0035]) that is immediately accessible by an operator who projects the facility [0012].

The prior art discloses different categories such as what type of substation to build, what to include in the substation, etc.

- b. the modules are equipped with unified software interfaces to application routines that, when executed on the projected facility, create tendering information about the projected family [0035]. Once all the selections are made, the AutoCAD begins to draw the station, by retrieving the pre-drawn symbols from a library and applying the respective symbols to the selected pre-designed substation.

Regarding claim 11, Garcia further discloses an operator to run the application routines ([0012]).

An interface for the modules would inherently be included.

Regarding claims 2 and 12:

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Garcia discloses the data processing device as claimed in claim 1, wherein

- a. in the categorization system each module is attached at least three independent searching indices characterizing at least a discipline ([0025] different types of facilities), a function ([0033] transformer, switch gear) and a technical specification of the pre-engineered part within the facility ([0042] voltage) and/or
- b. based on the categorization system a module browser with navigator for categorizing and searching modules in the library is provided ([0037]-[0039] AutoCAD program).

Regarding claim 12, Garcia further discloses a name and preview (figure 6).

Regarding claim 3:

Garcia discloses the data processing device as claimed in claim 1, wherein the modules are typified as core modules, which comprise sub-modules and/or articles ([0044]-[0045]), and as black-box modules ([0048]), which are freely definable from a user interface or are predetermined by a supplier.

Regarding claim 4:

Garcia discloses the data processing device as claimed in claim 3, wherein

- a. core modules are attached cost information by means of a bill of quantity comprising a number of occurrences of article-numbers and/or sub-modules containing article-numbers, and cost information about the articles is available from an article database ([0050]), and
- b. black-box modules are attached cost information by assigning the cost immediately, in particular integrally or subpart-wise, to the black-box modules themselves ([0050]).

Regarding claim 5:

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Garcia discloses the data processing device as claimed in any claim 1, wherein the modules are typified as rigid modules, which are unchangeable from a user interface ([0042] stations are preprogrammed), and as parametrizable modules, which have a parameter or parameter set that is changeable from a user interface and from a bill of quantity from which the sub-module can be called ([0033] three different top-ratings of transformers).

Regarding claim 6:

Garcia discloses the data processing device as claimed in claim 1, wherein

- a. the application routines comprise routines for automatic cost calculation ([0050]), for tender text accumulation, for technical data accumulation, and in practical, for drawing accumulation ([0047], [0049]) and/or
- b. every module has a module-descriptor comprising standardized module data characterizing the module and providing a standardized interface to the application routines for delivering the module data to the routines. An interface for the modules would inherently be included.

Regarding claim 7:

Garcia discloses the data processing device as claimed in claim 6, wherein the standardized module data comprise a bill of quantity and prices of articles ([0050]), technical data ([0042] voltage), a tender text, and 3D drawing ([0049]).

Regarding claim 8:

Garcia discloses the device of claim 1 wherein the module boundaries are defined to coincide with physical boundaries of a component of the facility ([0045]).

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Regarding claim 9:

Garcia discloses the device of claim 1, further comprising

- a. a module library and software tools for defining and/or importing new modules using the categorization system (**figure 1 126 macros, symbols**) and/or
- b. project memory space for downloading modules from the library for projecting and tendering purposes (**figure 1 126 AutoCAD Application, Menu**)

Regarding claim 10:

Garcia discloses use of a data processing device as claimed in claim 1 for computer-aided tendering of power supply facilities, in particular substations (abstract).

Regarding claim 13:

Garcia discloses the method of claim 11 wherein upon downloading a module into a project the module is assigned a model type, number (figure 6), and/or the module is automatically detached from the library and related cost information is automatically copied from an article database into the project and can be changed by an operator ([0050]).

Regarding claims 14-15:

Garcia discloses program code that when executed, perform the steps of claims 1 and 11 ([0012]; [0036]-[0038]).

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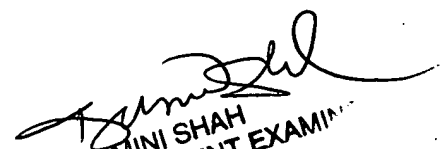
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shambhavi Patel whose telephone number is (571) 272-5877. The examiner can normally be reached on Monday-Friday, 8:00 am – 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamini Shah can be reached on (571) 272-2279. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SKP


KAMINI SHAH
SUPERVISORY PATENT EXAMINER